UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,476	05/24/2000	Raymond V. Damadian	DAMADIAN 3.0-076	4571

530 7590 09/26/2003

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
TUGBANG, ANTHONY D	
ART UNIT	PAPER NUMBER
3729	

DATE MAILED: 09/26/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/577,476	Applicant(s) DAMADIAN, RAYMOND V.	
	Examiner A. Dexter Tugbang	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *1-6 and 25-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/7/03 in the Request for Reconsideration (Paper No. 13) have been found to be persuasive with respect to the prior art rejections in the last Office Action (Paper No. 10). Accordingly, the previous rejections have been withdrawn. However, a new grounds of rejection is set forth below due to the newly discovered reference to Sasaki et al (U.S. Patent 3,813,767). Any delay in prosecution is deeply regretted.

Election/Restrictions

2. Claims 1-6 and 25-32 continue to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Drawings

3. The drawings were received on 7/7/03 (Paper No. 11). These drawings have been approved by the examiner.

Specification

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions,

wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because of the use of phrases already implied, i.e. “are disclosed” (lines 3-4 of the specification, page 16) and the abstract is not directed to the claimed invention, i.e. method. Correction is required. See MPEP § 608.01(b).

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A Method of Making Pieces for a Magnetic Resonance Imaging Magnet.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 17, it is unclear from the disclosure if the phrase of "any oily residue and other contaminants" (lines 2-3) is referring to the oily residue and contaminants in alternative form or both altogether, which renders the scope of the claim as being vague and indefinite.

In Claim 18, the same problems occur similarly as above with the phrase of "oxides, dirt and any other contaminants" (lines 2-3).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 7-12, 14 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al.

Sasaki discloses a method of making pieces comprising: providing an intermediate element (in Fig. 1a) including a plurality of ferromagnetic rods 11 with a dielectric material (molding material 12) therebetween; slicing the intermediate element along the lengthwise

direction to form shim pieces each having a thickness direction corresponding to the lengthwise direction of the rods in the intermediate element (see sequence of Figs. 1b-1c and col. 4, lines 39-41), which meets all of the limitations of the claimed manufacturing method.

Regarding Claims 8-12, Sasaki further teaches assembling the shim pieces with a magnet pole, i.e. closed magnetic circuit (at col. 2, lines 46-49), in the form of a substantially closed ring with a gap and having a generally accurate shape (see Figs. 2c and 2d).

Regarding Claim 14, Sasaki teaches an additional step of trimming after slicing, to alter the profile of the shim pieces (see col. 5, lines 2+).

Regarding Claim 19, Sasaki shows that the rods are covered with a rectangular shaped dielectric sleeve 12 (in Fig. 1b).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 13, 15-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al in view of Rudd et al 3,849,878.

Sasaki discloses the claimed manufacturing method as relied upon above.

Regarding Claims 13, 15 and 16, Sasaki does not specifically teach the use of a saw to perform the slicing or an abrasive jet or milling device to perform trimming.

Regarding Claims 17 and 18, as best understood, Sasaki does not teach cleaning or removing other contaminants.

Regarding Claims 20-23, Sasaki does not teach the use of a mold to form the dielectric, curing the dielectric, as well as the compositions of an epoxy or fiberglass.

Rudd teaches a manufacturing process that includes the use of a saw (see col. 3, lines 18-20) to perform slicing and a mold (see col. 4, line 10) to form the dielectric, cleaning and removing contaminants (see col. 2, lines 58+), the use of an epoxy or fiberglass as dielectric materials (see col. 3, lines 3-12), as well as curing the dielectric materials (see col. 3, lines 61+), all for the benefits of easier handling and a greater speed of manufacturing shim pieces (see col. 4, lines 35-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Sasaki by including the manufacturing process of Rudd, to positively provide easier handling and a greater speed of manufacturing shim pieces.

Regarding Claims 15, 16 and 24, it would have been an obvious matter of design choice to choose any desired means for slicing or trimming and cross-sectional shape of the rods, since applicant has not disclosed that the claimed abrasive jet, milling machine, or hexagonal cross-sectional shape, solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the means for slicing and trimming and cross-sectional shape taught by either Sasaki et al or Rudd et al. Furthermore, the claimed means for slicing and trimming and cross-sectional shape of the rods, as recited in either of Claims 15, 16 and 24, does not provide any manipulative difference in the claimed manufacturing method as compared to the prior art above.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A. Dexter Tugbang
Primary Examiner
Art Unit 3729

September 21, 2003